

### **REMARKS**

This is in response to the final Office Action mailed February 21, 2008. The Examiner notes that claims 1-22 are pending and rejected. By this response, the Applicant herein amends claims 1, 8 and 22. Support for the amendments may be found in the specification on at least page 25, lines 13-27 and FIGs. 4a and 4b.

In view of the following discussion and amendments, Applicant submits that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §103. Further, Applicant submits that all of the claims satisfy the requirements of 35 U.S.C. §112, ¶1. Thus, Applicant believes that all of the pending claims are now in allowable form.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

### **REJECTIONS**

#### **35 U.S.C. §112**

Claims 1, 8 and 22 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement, the Examiner stating that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is traversed.

With respect to the Examiner's assertion that "no single means for compressing both the program control information and the packaged television programs," the Applicant respectfully disagrees. (Emphasis in original). The Applicant's specification on page 25, lines 24-26 teaches that upon completion of the computer assisted packaging (CAP) functions, the Operations Center 202 compresses the signal for satellite transmission. With reference to page 25 and lines 18-21 and FIG. 4b, the Applicant's specification teaches that within module 246, the CAP combines the packaged programs and control information into a

single signal for transmission at box 282. The Subsequently, referring to FIG. 4a, the packaged programs and control information are compressed at box 284. Therefore, the Applicant respectfully submits that the Applicant's specification clearly discloses, in one embodiment, a single means for compressing both the program control information and the packaged television programs.

With respect to the separate decompression hardware, the Applicant respectfully submits that support was cited in the Applicant's specification in the Amendment of August 2, 2007. Specifically, the Applicant's specification fully supports the limitations regarding the separate decompression hardware on p. 30, lines 7-16 and p. 31, lines 3-8. For example, "[s]eparate decompressors for the video signals and program information signal allows for the greatest flexibility in the system and is therefor the preferred embodiment. A separate decompressor also assists in assuring that the switch from menus to television programming is smooth and without any significant time delay" (p. 30, lines 13-16). Therefore, the Applicant respectfully submits that the claims satisfy the requirements under 35 U.S.C. § 112 and request the rejection be withdrawn.

### **35 U.S.C. §103**

#### **Claim 22**

The Examiner has rejected claim 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,477,262 to Banker et al. (hereinafter "Banker") in view of U.S. Patent 4,706,121 to Young (hereinafter "Young"), U.S. Patent 4,975,771 to Kassatly (hereinafter "Kassatly") and U.S. Patent 4,845,662 to Tokumitsu (hereinafter "Tokumitsu"). Applicant respectfully traverses the rejection.

Independent claim 22 relates to a television delivery system, and recites:

22. A television delivery system for generating an interactive electronic program guide for display on a television connected to the set top terminal, the system comprising:
- an operations center comprising:
    - a means for packaging a plurality of television programs; and
    - a means for generating program control information including data associated with the packaging of the television programs;

a means for combining the packaged plurality of television programs and the generated program control information before performing compression;  
a means for compressing the packaged television programs and the program control information; and  
a means for delivering the compressed packaged television programs and the compressed program control information from the operations center to a subscriber;  
a set top terminal, located at the subscriber's location, that receives the television programs from the operations center, the terminal comprising:  
a microprocessor for executing program instructions;  
a graphic memory;  
a graphic generator to generate graphics from the graphic memory;  
a first decompression hardware for decompressing a video signal of the compressed packaged television programs;  
a second decompression hardware for decompressing the compressed program control information; and  
a subscriber interface for choosing an option from displayed graphics and for effecting the memory location from which graphical information is generated by the graphics generator;  
wherein the terminal generates an electronic program guide comprising:  
a plurality of interactive menus, each corresponding to a level of interactivity and having one or more interactive menu items for selection; and  
a main menu having one or more main menu items for selection, which main menu items correspond to the interactive menus, wherein the menus are navigated using a user input, and wherein the main menu items and the interactive menu items are responsive to selection signals received from the user input; and  
a cursor for navigation of the menus, wherein the cursor movement corresponds to the user input and assists in the selection of one or more main menu items wherein the menus are linked in a tree sequence, and the subscriber interface comprising the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence.

First, the Applicant respectfully submits that Kassatly, Tokumitsu, Young and Banker fail to teach or suggest a means for combining the packaged plurality of television programs and the generated program control information before performing compression. Notably, the Examiner relies on Kassatly and Tokumitsu which teaches separate compression of video programs and textual information. However, the Applicant's invention achieves efficiency over the combined teachings of Kassatly, Tokumitsu, Young and Banker by combining the packaged plurality of television programs and generated program control information before performing

compression and providing a means for compressing the packaged television programs and the program control information.

Moreover, as previously argued, Kassatly, Tokumitsu, Young and Banker fails to teach or suggest the subscriber interface comprising the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence. As stated by the Examiner, Banker fails to teach or suggest “the subscriber interface comprising the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence,” as recited in independent claim 22.

The Examiner alleges that Young teaches a user may indicate an option through a dedicated button on the remote control to bypass the program guide mode menu and allow immediate access to the television program listings (col. 10, line 13 - col. 12, line 30). The Examiner reasons that because the MG menu is displayed after the sequence of PG menus is completed that the MG menu constitutes a sub-menu of the PG main menu. (See Final Office Action, p. 3, ll. 6-14). The Applicant’s respectfully disagree.

The Examiner’s attention is directed to the fact that step 429 represents the end of the PG menu sequence. After completion of the PG menu sequence, the prime mode is exited and the MG menu is displayed. (See Young, col. 19, ll. 6-10). In other words, the MG menu is simply a default menu presented after completion of the PG menu. Consequently, contrary to the Examiner’s assertion, at best Young teaches that the PG menu is a submenu of the MG menu and not vice versa. As illustrated, the Examiner’s conclusion that “[t]hus, the MG menu display constitutes a sub-menu of the PG main menu” is untenable based on the teachings of Young.

Rather, a more plausible conclusion based on the teachings of Young is that the MG menu and PG menu are at best independent menus on the same level and not sub menus of one another. (See Young, FIG. 7). The Applicant notes that simply because the MG menu is displayed upon completion of a sequence of PG menus, does not teach or suggest that the MG menu is a sub-menu of the PG menu.

As previously argued, the Applicant respectfully submits that the Examiner has mis-interpreted Young's Figs. 7 and 10. Specifically, the direct selection of program listing via the MG (master guide) mode does not bypass any menu in the same manner as recited in Applicant's invention because Young's MG, PG (program guide) and TV menus are not related to each other in a tree sequence or in different menu levels.

The menus in Applicant's claim 22 are linked in a tree sequence, and "bypassing comprises skipping a menu level of the tree sequence" (emphasis added). For example, the main menu has one or more main menu items available for selections, which correspond to the interactive menus. Each interactive menu also has one or more interactive menu items for selection. Thus, the main menu and the interactive menu constitute different menu levels because the interactive menus are available for selection in the main menu.

By contrast, Young's MG, PG and TV menus correspond to the same level, and none of them is a sub-menu or option under the other menu. This can be understood by referring to Young's Fig. 5, Fig. 7 and Fig. 10 in conjunction with each other.

Fig. 5 shows a remote control panel for the TV system. Separate keys 222, 224 and 226 are used for selecting three parallel options: MG, PG and TV menus, respectively (see also Young, col. 9, lines 48-55). That is, MG, PG or TV are different options belonging to the same menu level because any of these menus can be selected totally independent of each other by using keys 222, 224 or 226.

Young's Figs. 6-13 are flow charts of the software used in the system (col. 6, lines 12-13), and Fig. 7 illustrates a command string flow diagram (col. 19, line 20), which shows the sequence of logical steps used in the software corresponding to which menu key (MG, PG or TV) is selected on the remote control.

Thus, if the MG key 222 is selected, the software executes a step according to the "yes" path in the MG box 320 in Fig. 7, which then leads to a MG display (whose software flow chart is shown in Fig. 8). But Fig. 7 does not correspond to

any menu displays/options per se, and certainly does not teach that the MG mode is a submenu of the PG menu.

Fig. 10 also does not show the MG mode being a sub-menu under the PG menu. Instead, Fig. 10 shows a software flow chart for the prime time mode, and illustrates the steps for detecting the start and end times in this mode, e.g., at decision boxes 423 and 429, respectively (col. 18, line 59 - col. 19, line 17).

Note that decision box 426 for MG is executed in the software only if the correct entries are not detected in box 424 (resulting in the "no" path leading to box 426). The system software checks whether the MG mode might have been selected, e.g., via key 222 on the remote, and if so, it results in the MG display. But Fig. 10 does not teach or suggest the MG menu as a sub-menu under the PG menu.

As explained above, the MG and PG menus belong to the same "menu level" because they are parallel options. There is no teaching of any tree sequence relationship among the MG, PG or TV menus, and the MG menu is not a sub-menu with respect to PG. Thus, there is no menu level to be skipped by selecting MG.

Thus, even if one were to interpret the exiting from the PG mode in Fig. 10 (by selecting MG key 222) as "bypassing" the PG mode, this "bypass" is still not performed in the same manner as Applicant's claim 22, because there is no tree sequence relationship among the PG, MG and TV menus, and selecting the MG mode does not skip any menu level in a tree sequence.

Since neither Kassatly nor Tokumitsu was cited in the Office Action as teaching this missing feature of Young and Banker, the combined teaching of these four references still would not have resulted in Applicant's invention because there is no teaching of the bypassing of a menu level in the manner recited in claim 22. Thus, the combined teaching of Banker, Young, Kassatly and Tokumitsu does not teach or suggest each and every feature in claim 22.

Accordingly, Applicant submits that independent claim 22 is non-obvious and patentable under 35 U.S.C. §103 over the combination of Banker, Young, Kassatly

and Tokumitsu. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

### **Claims 8-21**

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Banker in view of U.S. Patent 5,539,871 to Gibson (hereinafter "Gibson") and Young, Kassatly and Tokumitsu. Applicant respectfully traverses the rejection.

The Banker, Gibson, Young, Kassatly and Tokumitsu references, alone or in combination, fail to teach or suggest Applicant's invention as a whole.

Independent claim 8 recites certain features similar to those of claims 22 and 8, e.g., a means for combining the packaged plurality of television programs and the generated program control information before performing compression and wherein the overlay menu is displayed in response to a signal received from a user input and wherein the overlay menu is in a series of menus that are linked in a tree sequence and the subscriber interface comprises the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence.

As discussed above in connection with claim 22, the combined teaching of Banker, Young, Kassatly and Tokumitsu fails to teach or suggest at least the above features.

Since there is no argument put forth in the Office Action that Gibson teaches or suggests the above missing features, the combined teaching of Gibson, Banker, Young, Kassatly and Tokumitsu still would not have resulted in Applicant's invention of claim 8.

As such, independent claim 8 is patentable under 35 U.S.C. §103(a) over Banker in view of Gibson, Young, Kassatly and Tokumitsu. Claims 9-21 depend, directly or indirectly from independent claim 8 while adding additional elements. Therefore, claims 9-21 are also non-obvious and patentable over Banker in view of Gibson, Young Kassatly and Tokumitsu under §103. As such, Applicant respectfully

requests that the Examiner's rejection of claims 8-21 under 35 U.S.C. §103(a) be withdrawn.

### **Claims 1-7**

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,410,326 to Goldstein (hereinafter "Goldstein") in view of Banker, Young, Kassatly and Tokumitsu. The rejection is traversed.

Independent claim 1 recites certain features similar to those of claims 22 and 8, e.g., a means for combining the packaged plurality of television programs and the generated program control information before performing compression and wherein the series of menus are linked in a tree sequence and the subscriber interface comprises the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence.

Goldstein, Banker, Young, Kassatly and Tokumitsu, alone or in combination, fail to teach or suggest Applicant's invention as a whole.

As stated in the Office Action (page 20), Goldstein fails to teach or suggest at least the features of a means for combining the packaged plurality of television programs and the generated program control information before performing compression and wherein the series of menus are linked in a tree sequence and the subscriber interface comprises the option for bypassing at least one menu of the series of menus, wherein bypassing comprises skipping a menu level of the tree sequence, as recited in independent claim 1.

Furthermore, as set forth above in connection with independent claims 22 and 8, the combined teaching of Banker, Young, Kassatly and Tokumitsu also fails to teach or suggest the above missing features.

As such, Applicant submits that independent claim 1 is patentable under 35 U.S.C. §103(a) over Goldstein in view of Banker, Young, Kassatly and Tokumitsu.

Claims 2-7 depend, directly or indirectly from independent claim 1 while adding additional elements. Therefore, claims 2-7 are also non-obvious and



patentable over Goldstein in view of Banker, Young, Kassatly and Tokumitsu under §103 for at least the same reasons that claim 1 is patentable over Goldstein in view of Banker, Young, Kassatly and Tokumitsu under §103. As such, Applicant respectfully requests that the rejection of claims 8-21 under 35 U.S.C. §103(a) be withdrawn.

### **OFFICIAL NOTICES**

In rejecting certain claims, the Examiner has taken Official Notices in various portions of the Final Office Action, e.g., on p.17 that it is notoriously well known to simultaneously display a reduced version of a menu with a plurality of selections on the same display as video programming ...; on p.19 that it was notoriously well known to utilize data from a vertical blanking interval, and on p.20 that it was notoriously well known to display specific objects in a media presentation for at least 15 seconds during a plurality of ten-minutes segments of the program, among others.

Applicant respectfully submits that the Examiner has failed to properly establish official notice in these instances. Under MPEP 2144.03, the Examiner cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies. In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), emphasis added. Moreover, there must be some form of evidence in the record to support an assertion of common knowledge. See *Id.* Therefore, without supporting evidence, the Examiner fails to properly establish Official Notices.

### **CONCLUSION**

Thus, Applicant submits that all of the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it

is requested that the Examiner telephone Eamon J. Wall or Chin (Jimmy) Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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